

## REMARKS

Reconsideration and allowance of the claims are requested.

### Information Disclosure Statement

The Examiner has objected to the Information Disclosure Statement ("IDS") filed by the applicant on January 20, 2006, for failing to comply with 37 CFR 1.98(a)(3) because it did not include a concise explanation of the relevance of each listed reference that is not in the English language. This objection is respectfully traversed.

A concise explanation of the relevance of the two Spanish language references cited in the IDS (i.e., ES 2113820 and ES 2158751) may be found in the applicant's specification at page 3, line 21 – page 4, line 2. This is sufficient to satisfy the "concise explanation" requirement. MPEP 609.04

With respect to the two Japanese language references (JP 9263473 and JP 5194067), the applicant submits herewith as Exhibits A, B and C, respectively, copies of English language abstracts of the references and a copy of the international search report for the underlying PCT application which resulted in the instant application and which indicates the degree of relevance found by the International Searching Authority. It is believed that these exhibits are sufficient to fulfill the requirements for a concise explanation of relevance. MPEP 609.04

### Claim Objections

The claims have been amended to overcome the clerical objection set forth by the Examiner on page 3 of the Office Action, by adding an article ("A" or "The") at the beginning of each claim.

### 35 USC § 101/112 Rejections

The Examiner rejected claims 28 and 29 under 35 USC § 112 as being indefinite and under 35 USC § 101 for containing an improper definition of a process.

Those objections have been rendered moot by cancellation of claims 28 and 29.

The Examiner also rejected claims 26 and 27 as being indefinite for reciting a narrow range that falls within a broad range in the same claim.

That rejection has been overcome by deleting the narrower recitations from claims 26 and 27 and placing those recitations into newly added dependent claims. (See new claims 33 and 34).

### 35 USC § 103 Rejection

The Examiner has rejected claims 18-32 under 35 USC § 103 as being unpatentable over La Critique Belge (GB 1148307) in view of Yoshizo (JP 5194067) and further in view of Iritani (US 5,545,418). This rejection is respectfully traversed.

In the present application, the problem the inventor was concerned with is "related to the elimination of such a highly polluting residue produced in such large amounts as vinasses [...]" (page 3, lines 1-4). Thus, recycling of vinasses is the problem the inventor was concerned with, not "producing a granulated agricultural product", as alleged by the Examiner on page 8 of the Office Action.

#### 1. The prior art is not analogous

MPEP 2141.01 (a) states that in order to rely on a reference under 35 USC § 103, it must be analogous prior art. MPEP 2141.01 (a) explains that a prior art reference is analogous if the reference is in the field of the applicant's endeavour or if the reference,

because of the matter with which it deals, logically would have commended itself to the inventor's attention when considering the invention as a whole.

In this regard, La Critique Belge (hereinafter, "the '307 reference") is not in the field of the applicant's endeavour but in the field of Thomas slag-derived granulated fertilizers. The '307 reference is concerned with the problem of obtaining a satisfactory granulated fertilizer from Thomas Slag (page 1, line 11). In this regard, the reference is not pertinent to the problem the inventor was faced with. Therefore, the Examiner's conclusion of obviousness is based on impermissible hindsight reasoning. (MPEP 2142). Hindsight reasoning must "[...] not include knowledge gleaned only from applicant's disclosure" (In re McLaughlin, 443 F.2d 1392, 1395; 170 USPQ 209, 212 (CCPA 1971)). Here, the Examiner is taking into account knowledge gleaned only from the applicant's disclosure since producing an agricultural product from vinasses was unheard of at the time of the applicant's invention. At that time, all strategies for recycling vinasses available in the state of the art were related to "binding agent for manufacturing ceramic and refractory items; as a binding agent in animal food, ground stabilisation, production of light aggregates for civil construction work; in the manufacture of glues, for obtaining polymeric complexes with industrial application, in the manufacture of water reducers, sprayers, tensioactive products, adhesives, binders, etc." (Page 3, line 21 – page 4, line 2), none of which is remotely related to an agricultural product. Hence, the solution provided by the instant invention is a novel industrial application, fundamentally different from the ones available in the state of the art and non-obvious at the time of the applicant's invention.

2. The Requirements for a prima facie case of obviousness are not met

The Examiner contends that "[O]ne would have been motivated to make this combination in order to receive the expected benefit of having an alternative method of producing the granulated agricultural product [...]" (Office Action at page 8).

According to MPEP 2143, in order to establish a *prima facie* case of obviousness based on a teaching, suggestion or motivation to modify or combine references, at least two basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. In addition, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

MPEP 2143.01 III states that "the mere fact that references can be combined or modified does not render the resulting combination obvious unless the results would have been predictable to one of ordinary skill in the art.

MPEP 2143.01 IV states that "because the references relied upon teach that all aspects of the claimed invention were individually known in the art is not sufficient to establish a *prima facie* case of obviousness without some objective reason to combine the teachings of the references".

The '307 reference does not mention or suggest the desirability of adding liquid residues to Thomas slag. Further, vinasses may not be considered as one of the intended binding agents in the '307 reference, filed on 1966, since vinasses concentrators were not used before 1980. The knowledge available in the field of recycling vinasses at the time of the applicant's invention, does not express or suggest the desirability of turning vinasses into an agricultural product. Therefore, the first requirement for a *prima facie* case of obviousness is not met.

Regarding the second requirement, expectation of success is lacking from the modification of the '307 reference by addition of liquid vinasses to Thomas slag. The residue used as binder for granulation in the '307 reference cannot be vinasses for two main reasons. First, the process for the production of a granulated fertilizer requires a binder with a high percentage of dry material (e.g., 65-85% - See claim 12 of the '307

reference). At such concentrations, the inherent viscosity of vinasses precludes circulation within a pulverizing device, distributing devices or free flowing thin jets (page 1, line 81 of the '307 reference), all of which would be clotted and rendered useless by the vinasses. This problem is not solved by combination with Yoshizo, which turns liquid waste into a solid paste, or by further combination with Iritani et al.

Because the invention is new and unobvious, and because new and unobvious features of the invention have been specifically set forth in the claims, and because the references do not suggest those new and unobvious features, reconsideration and allowance of the claims are requested.

Should the Examiner have any questions concerning this Amendment, applicants request the Examiner to contact the Applicants' attorney, Craig Bailey, at (310) 824-5555.

Date: October 1, 2008

Respectfully submitted,

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308409.1

## © EPODOC / EPO

PN - JP9263473 A 19971007  
 TI - PRODUCTION OF MATERIAL FOR FERTILIZER COMPRISING RECOVERED SURPLUS JUICE AND THE LIKE  
 FI - C05F5/00 ; C05F17/00  
 PA - DAIKIN KK  
 IN - ONISHI KAZUYUKI  
 AP - JP19960073416 19960328  
 PR - JP19960073416 19960328  
 DT - I

## © WPI / DERWENT

AN - 1997-545424 [50]  
 TI - Production of fertiliser material from recovered juices - comprises mixing with solidifying agent, particularly sawdust, rice bran, wastes of cereals and wheat flour, evaporation and drying  
 AB - J09263473 Production of fertiliser material from recovered juices from palatable period comprises (1) mixing with a solidifying agent, particularly sawdust, rice bran, wastes of cereals and wheat flour, (2) evaporation and (3) drying to give granules.  
 - (Dwg.0/1)  
 IW - PRODUCE FERTILISER MATERIAL RECOVER JUICE COMPRISE MIX SOLIDIFICATION AGENT SAWDUST RICE BRAN WASTE CEREAL WHEAT FLOUR EVAPORATION DRY  
 PN - JP9263473 A 19971007 DW199750 C05F17/00 003pp  
 IC - C05F5/00 ; C05F17/00  
 MC - C04-A09F C04-A09G C04-A10 C14-T04 D05-B D05-D  
 DC - C04 D16  
 PA - (DAIK-N) DAIKIN KK  
 AP - JP19960073416 19960328  
 PR - JP19960073416 19960328

## © PAJ / JPO

PN - JP9263473 A 19971007  
 TI - PRODUCTION OF MATERIAL FOR FERTILIZER COMPRISING RECOVERED SURPLUS JUICE AND THE LIKE  
 AB - PROBLEM TO BE SOLVED: To recycle resources and to reduce the cost of juice and the like by subjecting the surplus juice and the like recovered after the termination of the expiration date to a granulation treatment, thereby forming a material for fertilizer.  
 - SOLUTION: The surplus juice and the like recovered after the termination of the expiration date are housed into a raw material tank. Sawdust, skin of grains, such as bran, and wheat flour are added as additives for solidification to the surplus juice and the like to concentrate the moisture to about 50 to 60%. The concentrated juice and the like are subjected to the solidification treatment by the hot air generated by a rotary type drying machine and is subjected to a deodorization treatment and thereafter, the juice and the like are subjected to the granulation treatment to a prescribed grain size distribution, by which the granular material for the fertilizer is obtd. The resulted granular material may be applied as it is as fertilizer or feed for domestic animal or may be used as the fertilizer by adding fertilizer components, such as nitrogen, phosphoric acid and potassium, thereto.  
 I - C05F17/00 ; C05F5/00  
 PA - DAIKIN KK  
 IN - ONISHI KAZUYUKI  
 ABD - 19980130  
 ABV - 199802  
 AP - JP19960073416 19960328

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PN - JP5194067 A 19930803  
 TI - POLLUTION CONTROL TREATMENT OF SHOCHU WASTE WATER  
 FI - A23K1/06 ; C05F5/00 ; C12F3/10  
 PA - MATSUMOTO YOSHIZO  
 IN - MATSUMOTO YOSHIZO  
 AP - JP19920007570 19920120  
 PR - JP19920007570 19920120  
 DT - I

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AN - 1993-278121 [35]  
 TI - Treatment of waste of Japanese distilled spirit - includes condensing waste and mixing with equal amts. of rice bran, wheat, bran, fish meal, silk worm, etc. granulating, etc.  
 AB - J05194067 Treatment is effected by condensing the waste and mixing with equal amt. of mixt. of rice bran, wheat bran, fish meal, silk worm pupa powder and oil meal, granulating the resultant mixt. and granulation for feeds and fertilisers.  
 - Waste of Japanese distilled spirit is condensed to give paste. The resultant paste is mixed with feed compsn. (e.g. rice bran, wheat bran, fish meal, silk worm pupa powder and oil meal) for domestic animals, granulated and dried to give feed or fertiliser compsn.  
 - USE/ADVANTAGE - Used to treat waste of Japanese distilled spirit without inconvenience to the public(Dwg.0/0)  
 IW - TREAT WASTE JAPAN DISTIL SPIRIT CONDENSATION WASTE MIX EQUAL AMOUNT RICE BRAN WHEAT BRAN FISH MEAL SILK WORM GRANULE  
 PN - JP5194067 A 19930803 DW199335 C05F5/00 003pp  
 IC - A23K1/06 ; C05F5/00 ; C12F3/10  
 MC - C04-A07D2 C04-B01C C04-B04M C12-L09 C12-M11D C12-N10 D03-G D05-D  
 DC - C04 D13 D16  
 PA - (MATS-I) MATSUMOTO K  
 AP - JP19920007570 19920120  
 PR - JP19920007570 19920120

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PN - JP5194067 A 19930803  
 TI - POLLUTION CONTROL TREATMENT OF SHOCHU WASTE WATER  
 AB - PURPOSE:To dissolve a pollution problem and to recycle a valuable resource by treating SHOCHU(Japanese distilled spirit) waste water as an industrial waste involving a troublesome problem about its treatment and converting it to a feed for domestic animals or to a fertilizer.  
 - CONSTITUTION:SHOCHU waste water is concentrated by filtration, etc., and the resultant paste-state SHOCHU lees are suitably blended with a formula feed, a grain flour, rice bran, a fish meal, a chrysalis powder, an oil meal, etc., in a ratio of <=50 pts.wt. based on 50 pts.wt. SHOCHU lees. The resultant mixture is granulated to a pellet or a granule and subsequently dried to produce a feed or a fertilizer.  
 I - C05F5/00 ; A23K1/06 ; C12F3/10  
 PA - YOSHIZO MATSUMOTO  
 IN - MATSUMOTO YOSHIZO  
 ABD - 19931119  
 ABV - 017627  
 GR - C1131  
 AP - JP19920007570 19920120

**A. CLASIFICACION DEL OBJETO DE LA SOLICITUD**

CIP<sup>7</sup> C05F5/00

De acuerdo con la Clasificación Internacional de Patentes (CIP) o según la clasificación nacional y la CIP.

**B. SECTORES COMPRENDIDOS POR LA BÚSQUEDA**

Documentación mínima buscada (sistema de clasificación seguido de los símbolos de clasificación)  
CIP<sup>7</sup> C05F, C05G

Otra documentación consultada, además de la documentación mínima, en la medida en que tales documentos formen parte de los sectores comprendidos por la búsqueda

Bases de datos electrónicas consultadas durante la búsqueda internacional (nombre de la base de datos y, si es posible, términos de búsqueda utilizados)  
CIBEPAT, EPODOC, WPI, PAJ

**C. DOCUMENTOS CONSIDERADOS RELEVANTES**

Categoría*	Documentos citados, con indicación, si procede, de las partes relevantes	Relevante para las reivindicaciones n°
X A	GB 1148307 A (LA CITRIQUE BELGE) 10.04.1969, todo el documento	1-6,8,10-15 9
X A	JP 5194067 A (MATSUMOTO YOSHIZO) 03.08.1993 (resumen) World Patent Index [en línea]. DW199335. N° de acceso: 93-278121. [recuperado el 11.08.2004]. Recuperado de: EPO WPI Database.	1-3,5,6,8,9, 11,12 13-15
A	JP 9263473 A (DAIKIN KK) 07.10.1997 (resumen). [en línea][recuperado el 11.08.2004]. Recuperado de: EPO PAJ Database.	13-15

☐ En la continuación del recuadro C se relacionan otros documentos

☒ Los documentos de familias de patentes se indican en el anexo

- \* Categorías especiales de documentos citados:
- "A" documento que define el estado general de la técnica no considerado como particularmente relevante.
  - "E" solicitud de patente o patente anterior pero publicada en la fecha de presentación internacional o en fecha posterior.
  - "L" documento que puede plantear dudas sobre una reivindicación de prioridad o que se cita para determinar la fecha de publicación de otra cita o por una razón especial (como la indicada).
  - "O" documento que se refiere a una divulgación oral, a una utilización, a una exposición o a cualquier otro medio.
  - "P" documento publicado antes de la fecha de presentación internacional pero con posterioridad a la fecha de prioridad reivindicada.

- "T" documento ulterior publicado con posterioridad a la fecha de presentación internacional o de prioridad que no pertenece al estado de la técnica pertinente pero que se cita por permitir la comprensión del principio o teoría que constituye la base de la invención.
- "X" documento particularmente relevante; la invención reivindicada no puede considerarse nueva o que implique una actividad inventiva por referencia al documento aisladamente considerado.
- "Y" documento particularmente relevante; la invención reivindicada no puede considerarse que implique una actividad inventiva cuando el documento se asocia a otro u otros documentos de la misma naturaleza, cuya combinación resulta evidente para un experto en la materia.
- "&" documento que forma parte de la misma familia de patentes.

Fecha en que se ha concluido efectivamente la búsqueda internacional.

16 Agosto 2004 (16.08.2004)

Nombre y dirección postal de la Administración encargada de la búsqueda internacional O.E.P.M.

C/Panamá 1, 28071 Madrid, España.  
N° de fax 34 91 3495304

Fecha de expedición del informe de búsqueda internacional

24 SEP 2004

24. 09. 2004

Funcionario autorizado

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Formulario PCT/ISA/210 (segunda hoja) (Enero 2004)

**EXHIBIT C**

Documento de patente citado en el informe de búsqueda	Fecha de publicación	Miembro(s) de la familia de patentes	Fecha de publicación
GB 1148307 A	10.04.1969	BE 664113 A NL 6604826 A FR 1477842 A DE 1592761 B	16.09.1965 21.11.1966 21.04.1967 20.08.1970 20.08.1970
JP5194067 A	03.08.1993	NINGUNO	-----
JP9263473 A	07.10.1997	NINGUNO	-----